

REMARKS

The present invention is directed to a digital video and graphic stream and enables a reproduction apparatus to separately decode the video stream and the graphic stream, and to overlay the resulting video with graphics at a predetermined Window location and time.

The present invention lessens hardware cost and enables competitive lower price reproducing apparatus to be sold, while facilitating smooth movement of the graphics to the user. Control information is provided in packets that indicate when graphics data contained in a preceding packet in a sequence of frames is to be displayed at a predetermined time on a graphics plane. The position of the graphics on the plane can be changed with control information showing new coordinates for the graphics. For example, if subtitling is to be superimposed on a video stream of a movie, a Window can be provided that will be maintained over a series of frames during a display time period.

Synchronization of video and graphic data for a page or Window composition segment is provided within the graphics stream in packets which can be processed during decoding to remove packet headers for subsequent appropriate processing to enable the composition of the graphics and the assembling of each page.

A graphic image can be stored in the reproduction apparatus and then subsequently forward referenced by a page composition segment, and since the graphic is already stored in the reproduction apparatus, for example an object buffer, there is no waiting for a decoding so that the display control can be promptly carried out.

Claims 1-3, 6 and 14 were rejected under 35 U.S.C. §101 as being drawn to a non-statutory recording medium.

Independent Claims 1 and 14 have been amended to address the §101 rejection. If the Examiner has any questions, the undersigned attorney would appreciate a phone conference.

The Office Action applied the *Okada et al.* (PCT Publication WO 2004/098193) to reject each of the Claims 1-3, 6-9 and 12-15 under 35 U.S.C. §102(e). Claims 3-6 and 9-12 are now cancelled.

The Office Action contended that the *Okada* reference taught a digital stream generated by multiplexing a video stream and a graphics stream with the graphics stream having a plurality of packets that could contain control information. Control information further indicating that the graphic data contained in a preceding packet is to be displayed at a predetermined time in a state of being overlaid on a video stream. The Office Action further contended, with reference to Figure 31, that an EPOCH start, acquisition point and normal case was taught. The Office Action referred to an EPOCH Start DS having information necessary for displaying a next screen composition in a display set provided that the start of memory management of a reproduction time axis.

However, the information relied upon as anticipatory information under 35 U.S.C. § 102(e) represented the work of Joseph McCrossan and Tomoyuki Okada. This work was reduced to a written form and recorded in the United States Patent Office as US Provisional Application No. 60/465,972 on April 28, 2003. This information is of record in the United States Patent Office and more than adequately establishes an enabling of a reduction to practice of the invention or at least a conception of the claimed invention that the respective inventors, Mr. McCrossan and Mr. Okada, subsequently, diligently pursued by the preparation and filing of US

Provisional Application 60/483,228 on June 8, 2003 which is the provisional application forming the basis of the current application in prosecution.

Thus, the information set forth and disclosed in the corresponding Figures and specification relied upon in the Office Action to reject the claims at issue including, but not limited to, Page 3 lines 11-22, Page 11 line 28 to Page 12 line 4, Page 13 line 22 through Page 14 line 28, Page 44 line 4-6 and Page 45, lines 7-10 represent the work of Joseph McCrossan and Tomoyuki Okada.

The Office Action correctly identified that common inventors, namely Tomoyuki Okada and Joseph McCrossan existed in the cited PCT WO 2004/098193 publication and also in the current patent application, and indicated that an appropriate showing under either 37 CFR §1.132 or 37 CFR §1.131 could overcome this §102(e) rejection.

Since the PCT WO 2004/098193 application was published in English, in accordance with MPEP §1857.01, the effective prior art date is the priority date of April 28, 2003. The present application has the benefit of our provisional application of 60/483228 date of June 30, 2003.

The Examiner was correct in identifying the similarity in the disclosures as the work of common inventorship. Accordingly, applicant is submitting Declarations pursuant to 35 U.S.C. §102(e) that the work of the two inventors, Okada and McCrossan, were conceived prior to the effective prior art date of April 28, 2003 and that such common subject matter is not the invention of another.

The Declarations of Tomoyuki Okada and Joseph McCrossan establish a conception of the present invention prior to the effective date of the cited PCT Publication WO 2004/098193

and more specifically, discloses facts of a character and weight that more than adequately supports the removal of the cited PCT publication as prior art.

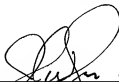
Finally, the Declaration of Tomoki Ogawa, the other joint inventor of the PCT Application Publication WO 2004/098193 A2 affirms the work of Mr. Okada and Mr. McCrossan.

It is believed that the present application is now in condition for allowance and an early notification of the same is requested.

If the Examiner believes that a telephone interview will help further the prosecution of this case, he is respectfully requested to contact the undersigned attorney at the listed telephone number.

Very truly yours,

SNELL & WILMER L.L.P.



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